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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,492	06/25/1999	JOHN S. HENDRICKS	026880.00029	9126

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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/344,492

Applicant(s)

HENDRICKS ET AL.

Examiner

Jason P. Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 23-41 and 47-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-16 and 36-40 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 17, 23-28, 31-34, 41 and 47-53 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 11, 29, 30 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/24/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/10/2006 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 10/24/2006 regarding all U.S. Patent and Patent Application Publications was filed after the mailing date of the Final Rejection on 06/26/2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

3. The information disclosure statement filed 10/24/2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because for all foreign applications and published articles (NPL documents) a copy has not been provided to the examiner. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes

of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 2 and 26 state, "wherein the rating can be assigned to the electronic book by a publisher at an **operation center and by a user**". The specification states on Page 52, Lines 24-26, "*standard ratings may be entered by a user or may be predetermined by, for example, a publisher or an operations center*". Therefore, the specification fails to teach both the user **and** the operations center setting the ratings.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 25 contain an improper Markush regarding the claim limitations that state, "receiving information on whether the electronic book contains a restriction based on content, a rating, an associated access level, a page order based restriction, a time based restriction". The claim does not recite if the restrictions are all received or in the alternative, therefore the scope of the claim cannot be determined. In accordance with the specification (see Figure 29) the examiner notes that the restrictions appear to received separately, therefore the scope of the claim should be clarified to state that the restrictions are provided in the alternative (therefore an "or" limitation should be added).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4, 7-10, 17, 23-26, 28, 31-34, 41 and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handelman et al. (U.S. Patent 6,298,441) in view of Duga et al. (U.S. Patent No. 6,195,667).

Referring to claim 1, Handelman discloses restricting access to electronic books displayed on a viewer (see Figure 12 and Column 7, Line 66 through Column 8, Line 11).

Handelman also discloses displaying an identification of an electronic book on a viewer (see screen 425 in Figure 12 and Column 2, Lines 40-44 and Column 16, Lines 45-56 and Column 17, Lines 16-31).

Handelman also discloses receiving identification information from a user (see Column 15, Lines 41-43).

Handelman also discloses receiving information on whether the electronic book contains a restriction based on a rating (see Column 15, Lines 43-50) and if the electronic book contains at least one restriction, whether the restriction applies to the identified user (see Column 16, Lines 25-31).

Handelman also discloses restricting access to the electronic book based upon the information (see Column 16, Lines 1-6 for receiving the electronic book only if the user is authorized based on authorization information described above).

Although Handelman teaches receiving the electronic book data to a library unit (see Column 6, Lines 33-44), Handelman fails to teach receiving and updating directory data of the electronic books in a library unit.

Duga discloses receiving and updating directory data of the electronic books in a library unit (see Column 1, Lines 50-65).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Handelman,

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using the electronic book menu updating method, as taught by Duga, for automatically updating a menu after an electronic book is downloaded to a device, as opposed to a user having to manually enter the title of the electronic book every time the user downloads the electronic book to his/her device.

Referring to claim 2, Handelman discloses wherein the restricting step includes restricting the access based upon a rating assigned to the electronic book (see Column 15, Lines 49-50 for the authorization information containing ratings information used in determining if the user will be restricted access to the electronic book), wherein the rating can be assigned to the electronic book by a user (see Column 15, Lines 47-50).

Referring to claim 4, Handelman discloses receiving a restriction on selected content from a user, wherein the content includes text of the electronic book (see Column 18, Lines 24-40).

Handelman also discloses saving a first restricted version of the electronic book in the library unit including the original format of the electronic book (see Column 17, Lines 28-36).

Handelman also discloses creating a second unrestricted version of the electronic book by deleting the selected content (see Column 17, Lines 2-36 and Column 18, Lines 24-39).

Handelman also discloses saving the second unrestricted version of the electronic book in the library unit (see Column 17, Lines 27-36).

Referring to claim 7, Handelman discloses permitting viewing of only selected pages of the electronic book (the examiner notes that an electronic book inherently contains multiple pages, therefore if an entire electronic book or a portion thereof not permitted access at the viewer (see the rejection of claim 4 above), then the system inherently only permits viewing of selected pages of the electronic book).

Referring to claim 8, Handelman discloses permitting viewing of no portion of the electronic book (see Column 16, Lines 18-31 for only accessing the electronic book is authorized, therefore if the user is not authorized, he/she will view no portion of the electronic book).

Referring to claim 9, Handelman discloses permitting unlimited access to the electronic book (see Column 16, Lines 33-36 for storing the document/electronic book on the smart cards memory 395 and Column 16, Line 64 through Column 17, Line 19 for accessing the electronic book from the smart card's memory using the authentication data, therefore, a user can access the electronic book an unlimited amount of times based on if the user is authenticated to access the electronic book stored in the smart card's memory 395).

Referring to claim 10, see the rejection of claims 1 and 4 and further note that Handelman also discloses receiving information relating to access to the electronic book

by potential users (see Column 15, Lines 33-50 for the CA document loading unit 350 receiving requests for electronic books) and further relating to content of the electronic book (see Column 15, Lines 43-50 for the request information including various types of content related information of the electronic book).

Referring to claim 17, see the rejection of claim 10.

Referring to claims 23-24, see the rejection of claim 1.

Referring to claims 25-28, see the rejection of claims 1-4, respectively.

Referring to claims 31-33, see the rejection of claims 7-9, respectively.

Referring to claim 34, see the rejection of claim 10.

Referring to claim 41, see the rejection of claim 10.

Referring to claims 47-48, see the rejection of claims 23-24, respectively.

7. Claim 3, 27 and 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Handelman et al. (U.S. Patent 6,298,441) in view of Duga et al. (U.S. Patent No. 6,195,667) in further view of Block et al. (U.S. Patent No. 6,675,384).

Referring to claim 3, Handelman and Duga disclose all of the limitations in claim 1, as well as Handelman teaching that the restricting step includes permitting viewing of text within the electronic book (see Column 2, Lines 39-43), but fails to teach permitting no viewing of images within the electronic book.

Block discloses creating an image mask to block an image from being displayed (see Figure 11 and Column 18, Lines 55 through Column 19, Line 17). Further note

that Block clearly teaches that the system can be implemented in an electronic book system (see Column 2, Lines 50-56).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book viewer, as taught by the combination of Handelman and Duga, using the masking technology, as taught by Block, for the purpose of providing a substitute program signal instead of the offensive or undesirable portions of a program/book (see Column 2, Lines 19-22 and 50-56 of Block).

Referring to claim 27, see the rejection of claim 3.

Referring to claim 49, Handelman discloses access level information for an electronic book (see the rejection of claim 1), but fails to teach that such information is included in a header of an electronic book.

Block discloses placing ratings data in a header of transmitted data in Table I (see Column 6, Lines 35-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the document (book) data, as taught by Handelman and Duga, using the header, as taught by Block, for the purpose of providing desired codes for labeling and controlling the program signals transmitted to the viewer station equipment (see Column 5, Lines 41-44 of Block).

8. Claims 50-51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Huffman et al. (U.S. Patent No. 5,761,681) in view of Duga et al. (U.S. Patent No. 6,195,667) in further view of Handelman et al. (U.S. Patent 6,298,441).

Referring to claim 50, Huffman discloses electronically displaying a page of an electronic book on a viewer (see Figure 5) and permitting a user to restrict content of the electronic book (see Figure 37).

Huffman also discloses displaying a screen on a viewer (see Figure 5 for displaying a screen on the electronic book viewer).

Huffman also discloses displaying within the screen a page of an electronic book (see step 450 in Figure 38 for displaying a current page of the electronic book), the page including at least a portion of content of the electronic book (see Column 17, Lines 56-59 for displaying a page which includes a portion of the electronic book).

Huffman also discloses permitting a user to identify at least a portion of the content displayed within the screen (see step 454 in Figure 38 which allows a user to select a portion of the text in the currently displayed page of the electronic book (also note Column 24, Lines 1-2).

Huffman discloses displaying a section within the screen for permitting the user to request restriction of the identified content (see Column 24, Lines 2-13 for requesting a substitute name in a dialog box display section). The examiner notes that by replacing a name with a new name, restriction to the name is accomplished.

Although Huffman discloses receiving and storing the electronic book in a library unit (see Column 6, Lines 3-8), Huffman fails to disclose indexing the electronic book

within an index of the library unit and displaying a screen with the index having the electronic book.

Duga discloses storing and indexing an electronic book in a library unit (see Column 1, Lines 50-65) and displaying a directory having the stored electronic book on a viewer (see Column 1, Lines 61-63).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Huffman, using the electronic book menu updating method, as taught by Duga, for automatically updating a menu after an electronic book is downloaded to a device, as opposed to a user having to manually enter the title of the electronic book every time the user downloads the electronic book to his/her device.

Handelman discloses receiving a restriction on selected content from a user, wherein the content includes text of the electronic book (see Column 18, Lines 24-40).

Handelman also discloses saving a first restricted version of the electronic book in the library unit including the original format of the electronic book (see Column 17, Lines 28-36).

Handelman also discloses creating a second unrestricted version of the electronic book by deleting the selected content (see Column 17, Lines 2-36 and Column 18, Lines 24-39).

Handelman also discloses saving the second unrestricted version of the electronic book in the library unit (see Column 17, Lines 27-36).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Huffman and Duga, using the multiple version storage and portion restriction functionality, as taught by Handelman, for the purpose of providing a secure access system for electronic books (see Column 1, Lines 11-12 of Handelman).

Referring to claim 51, see the rejection of claim 50.

9. Claims 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Der Meer (U.S. Patent No. 6,415,316) in view of Duga et al. (U.S. Patent No. 5,761,681).

Referring to claim 52, Van Der Meer discloses electronically displaying a page of an electronic book on a viewer (see browser 110 in Figure 1(c) for a viewer and Column 5, Lines 36-39 and Column 6, Lines 40-43 for displaying a page of an electronic book in the viewer) and permitting a user to restrict content of the electronic book (see Figure 4(d) and Column 10, Lines 28-54).

Van Der Meer also discloses displaying a screen on a viewer (see Column 9, Lines 7-9 and browser 110 in Figure 1(c)).

Van Der Meer also discloses a name section within the screen for identifying a potential user of the viewer (see Figure 4(d) for displaying a name section for identifying a potential user of the viewer in the form of a password entry field).

Van Der Meer also discloses displaying an access level section within the screen for permitting entry of an access level for the user (see Figure 4(d) and Column 10,

Lines 29-31), the access level being used for restricting access to the electronic books by the user (see Column 2, Lines 40-46 and Column 10, Lines 43-45 for restricting access to certain functions of the electronic books presented in the viewer).

Van Der Meer also discloses displaying a viewer mode section within the screen for receiving entry of a viewer mode (see Column 2, Lines 25-31 and Column 5, Lines 9-25 and Column 9, Lines 32-39 for selecting a particular theme (viewer mode)), the viewer mode being used for determining a type of information used to restrict access to the electronic books (the examiner notes that if a "car" theme is selected (see Column 9, Lines 32-39), then the "car" theme (viewer mode) dictates that all other content from electronic books, except for the "car" theme is restricted).

Although Van Der Meer discloses that electronic book data can be received over a network (see Column 5, Lines 47-54), Van Der Meer fails to disclose indexing the electronic book within an index of the library unit and displaying a screen with the index having the electronic book.

Duga discloses storing and indexing an electronic book in a library unit (see Column 1, Lines 50-65) and displaying a directory having the stored electronic book on a viewer (see Column 1, Lines 61-63).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Van Der Meer, using the electronic book menu updating method, as taught by Duga, for automatically updating a menu after an electronic book is downloaded to a device, as

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opposed to a user having to manually enter the title of the electronic book every time the user downloads the electronic book to his/her device.

Referring to claim 53, see the rejection of claim 52.

Allowable Subject Matter

10. Claims 5-6, 11, 29-30 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 12-16 and 36-40 are allowed.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce
Primary Examiner
Art Unit 2623

December 13, 2006

JASON SALCE
PRIMARY PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'Jason Salce', written in a cursive style.